

REMARKS

Reconsideration of the subject application in view of the above amendment and the following remarks is respectfully requested. Based on the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

The Examiner has rejected claims 11 and 12 under 35 USC 112, first paragraph, as failing to be enabling. Applicant respectfully disagrees with this rejection. The feature that “at least one route table has a data structure that is different from a table structure” is supported by the disclosure on page 13, lines 21-24 of the specification. Accordingly, Applicant respectfully requests withdrawal of this rejection to claims 11 and 12.

The Examiner has rejected claims 6-8 under 35 USC 112, second paragraph, as being indefinite. Applicant has amended claim 6 to overcome this rejection. Support for the amended language is found in the specification on page 13, lines 11-13. Accordingly, Applicant respectfully requests withdrawal of this rejection to claims 6-8.

The Examiner has rejected claims 1, 2, 5, 10 and 13-17 under 35 U.S.C. § 103(a) as being anticipated by Perlman et al., U.S. Patent No. 6,526,055 (Perlman). The Examiner has rejected claims 4 and 9 under

35 U.S.C. § 103(a) as being unpatentable over Perlman in view of Ayandeh, U.S. Patent No. 6,069,895 (Ayandeh). It is respectfully submitted that the pending claims are patentable over the cited references.

In the Office Action, the Examiner argues that independent claims 1 and 16 and claims 2, 5, 10, 13-15 and 17 that depend therefrom respectively are anticipated by Perlman. Applicants respectfully disagree.

Claim 1 relates to a method for processing and forwarding data packets. Accordingly, an important feature of the invention is that an operation is executed on tokens that are composed of a selector and a data part. This feature is clearly recited in claim 1. The selector is not a prefix nor is any longest prefix match necessary.

In contradistinction, Perlman describes an apparatus for “comparing a packet prefix (destination addresses) to table index (destination address) for performing the operation of forwarding.” (see page 4). Thus, the apparatus of Perlman operates on prefixes. Moreover, Figs. 4-15 of Perlman specifically relate to prefixes, padding and bit-wise comparisons. Perlman does not teach, disclose or suggest performing an operation on the data packet itself.

Further, the method disclosed in Perlman and the method of the invention address different semantic levels. Perlman relates to the matching of a specially

formed header field (destination address) and masks. Perlman does not address the processing of packets. Thus, Perlman assumes a single step and unalterable forwarding process. In contradistinction, the invention relates to processing of complete tokens. These tokens with their data/packet part, as discussed in the specification, can be modified, consumed or extended.

Several passages in Perlman clearly show these differences. For example, in col. 7, lines 15-30 that refer to Fig. 5, it is disclosed that Perlman does not store operation codes in the router base, as defined in the claim 1 of the invention. According to Fig. 6a-d only “associated routing and forwarding information”, but not any packet processing or operation code information, is stored in the database.

The Federal Circuit has mandated that 35 U.S.C. § 102 requires no less than “complete anticipation...[a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); See also, Electro Medical Systems, 32 U.S.P.Q. 2d at 1019; Verdegaal Bros., 2 U.S.P.Q. 2d at 1053.

In view of the above, since Perlman does not disclose all the features of claim 1 and 16, it is respectfully submitted that Perlman does not anticipate the

present invention, as defined by claims 1 and 16. It is respectfully submitted that claims 1 and 16 are patentable over the prior art. Accordingly, it is respectfully submitted that claims 1 and 16 and claims 2, 5, 10, 13-15 and 17 that depend therefrom respectfully are patentably distinct over each such art and thus withdrawal of such rejection over such claims is respectfully requested.

In the Office Action, the Examiner argues that claims 4 and 9 are unpatentable over Perlman in view of Ayandeh. Applicants respectfully disagree. Moreover, Applicants respectfully submit that these two references cannot be combined.

Perlman relates to handling prefixes while Ayandeh relates to architecture of a route server with no suggestion of prefix matching. Thus, one skilled in the art would not find any reason in either reference to combine the references.

It is respectfully submitted that a *prima facie* case of obviousness has not been made. Even if the cited prior art could be construed to disclose certain matter as contended by the Examiner, no disclosure or suggestion in any of the cited prior art can be found which should lead a skilled artisan to combine their various features to achieve the claimed invention. That separate features of different references may not properly be combined, in the absence of some

specific teaching that they should or could be so combined, is such well-settled law that it hardly need be repeated here. See, e.g., In re Newell, 13 U.S.P.Q. 2d 1248, 1250 (Fed. Cir. 1989), citing Smithkline Diagnostis v. Helena Laboratories Corp., 8 U.S.P.Q. 2d 1468, 1475 (Fed. Cir. 1988). In order to reach the conclusion that the claimed subject matter as a whole would have been obvious, there must have been some teaching, suggestion, or inference in either reference, or both, which would have led one of ordinary skill to combine the relevant teaching of the references. ACS Hospital System, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). No such teaching, suggestion or inference could be found in any of the cited prior art.

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

The In re Fritch holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicant’s own statements”. The prior art must be viewed “without reading into that art Appellant’s teachings” and the teachings of the prior art should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the

original text) make the invention as a whole, obvious.” In re Sponnoble, 160 U.S.P.Q. 237, 243 (CPA 1969).

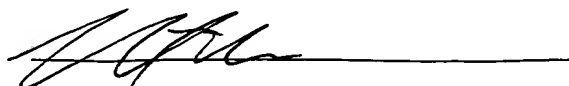
It is respectfully submitted that the teachings of the prior art does not make the present invention, as claimed in claims 4 and 9 obvious. Accordingly, Applicants respectfully request withdrawal of the obviousness rejection to such claims.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully Submitted,

A handwritten signature in dark ink, appearing to be 'J. P. M.', followed by a horizontal line.

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